

STATEMENT OF SUBSTANCE OF INTERVIEW

Applicants wish to express appreciation to Examiner Pritchett for the telephone interview of August 16, 2005. During the telephone interview, Applicants' Representative, Attorney William Boshnick, spoke to the Examiner concerning the rejected claims of the present invention. Specifically, Applicants' Representative, argued that the applied WU reference did not teach or suggest at least the microphone provided on a bottom face of the binoculars as claimed in claim 1, but rather completely fails to disclose the location of the microphone. Additionally, it was argued by Applicants' Representative that paragraphs [0021] and [0022] of WU (identified by the Examiner) merely note that image/audio signal compression and storage parts are located in the digital storage unit 2, shown on top of the binoculars in Fig. 1. The Examiner countered that since the image/audio signal compression and storage parts are located in the digital storage unit 2, then the microphone was likely located in WU's digital storage unit as well.

When Applicants' Representative noted that the digital storage unit was on an upper face (and not a bottom face) of the binoculars of WU, the Examiner countered (as asserted in the Official Action) that these binoculars can be used in either the upright position as shown in Fig. 1, or in an upside down position from Fig. 1, which would place the microphone of WU on a bottom face of the binoculars. Applicants' Representative noted that such an interpretation was not reasonable, since Fig. 1 of WU shows the device in its intended upright position, and it is not reasonable to assume

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that a user would turn the WU device upside down to use it, any more than it would be for a user to turn a camera or a pair of binoculars upside down and use them.

The Examiner suggested that Applicants include the above arguments in a substantive Response, whereupon the Examiner would reconsider the rejection, and may issue a subsequent rejection under 35 U.S.C. § 103 (using the same WU reference), in that it may be obvious to include a microphone in a bottom face of a pair of binoculars. Applicants' Representative noted that in prior art binoculars (as described in the "Description of Related Art" section of the present application), "the microphone of the convention digital camera is disposed on the front side (lens provided side) of the camera body, beside the finder, or on the top surface of the camera body, which is not suitable for recording a voice of a user when the user is looking into the viewfinder." Applicants' Representative further noted that the present invention is useful for bird-watching, and as such, a microphone on located a bottom surface, or underside, of the binoculars is positioned closer to the user's mouth so that the user need not amplify his/her voice to ensure recordation, which may otherwise (as with convention digital camera-equipped binoculars) scare birds away.

The Examiner countered that it is reasonable for a user to use the binoculars of WU in an upside down position, and that it may be obvious to include the microphone in the digital storage unit 2 of WU so that the microphone is closer to the image/audio signal compression and storage parts to prevent signal degradation, to which Applicants' Representative did not agree.

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The Examiner (as noted in the Interview Summary of August 16, 2005), suggested some claim limitations that may overcome WU, for example, that the digital camera and the microphone are mounted on different surfaces of the binoculars. Applicants appreciate the Examiner's suggestions and note that new claim 7 has been presented in this regard.

REMARKS

Applicants would like to express appreciation to the Examiner for the detailed Official Action provided. Upon entry of the present amendment, claim 7 will have been added, with claims 1-7 pending in the present application for consideration by the Examiner.

The Examiner has rejected claims 1 and 3-6 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2005/0018048 to WU, finding that this reference teaches all limitations of these claims.

Applicants respectfully traverse the Examiner's rejection. Applicants submit that WU, as well as the other references of record, are markedly different from the present claimed invention. Specifically, as discussed *supra*, WU does not teach or suggest the claimed microphone provided on a bottom face of the binoculars, but rather completely fails to disclose the location of the microphone. Further, as discussed *supra*, paragraphs [0021] and [0022] of WU (identified by the Examiner) merely note that image/audio signal compression and storage parts are located in the digital storage unit 2, shown on top of the binoculars in Fig. 1. Neither the specification nor the drawings of WU disclose the claimed location of the microphone, and an anticipation cannot be based on teachings in a reference that are vague or based on conjecture. See *Datascope Corp. v. SMEC, Inc.*, 227 USPQ 838 (Fed.Cir. 1985).

Additionally, as noted *supra*, the broadest *reasonable* interpretation of WU is that the binoculars can only be used in the upright position (in relation to a user's face) as shown in Fig. 1. Since WU is silent as to the positional relationship of the binoculars of

Fig. 1, it is reasonable to conclude that the binoculars are shown in its intended upright position (in relation to the user's face). As noted *supra*, it is not reasonable to assume that a user would turn the WU device upside down to use it, any more than it would be for a user to turn a camera or a pair of binoculars upside down (in relation to a user's face) and use them. In view of the above, it is respectfully submitted that WU, as well as the other references of record, fails to teach or suggest the invention of independent claim 1, as well as the claims dependent therefrom.

With respect to the Examiner's rejection of dependent claims 3-6, since these claims (as well as newly added claim 7) are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(e).

Should the Examiner determine, in a subsequent rejection under 35 U.S.C. § 103, that it is obvious to include a microphone in a bottom face of a pair of binoculars,

Applicants note that in prior art binoculars (as described in the "Description of Related Art" section of the present application), "the microphone of the convention digital camera is disposed on the front side (lens provided side) of the camera body, beside the finder, or on the top surface of the camera body, which is not suitable for recording a voice of a user when the user is looking into the viewfinder." As discussed *supra*, the present invention is useful for bird-watching, and as such, a microphone on located a bottom surface, or underside, of the binoculars is positioned closer to the user's mouth so that the user need not amplify his/her voice to ensure recordation, which may otherwise (as with convention digital camera-equipped binoculars) scare birds away.

Further, even if it were considered to be reasonable to use the device of WU upside down, and even if it were considered to be reasonable to include the microphone in the digital storage unit 2, there is still no motivation to include a microphone on a "bottom face" (the top of the storage unit 2 as shown in Fig. 1) of WU, since locating the microphone in the front face (i.e., on the same face as the camera portion 21) would also ostensibly prevent signal degradation to the same degree (since WU does not disclose the particular location of the mage/audio signal compression and storage parts). It is thus submitted that claim 1 (and the claims dependent therefrom) is also patentable under 35 U.S.C. § 103 over the art of record.

With respect to the Examiner's rejection of dependent claims 2 under 35 U.S.C. § 103(a), since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, all dependent claims recite additional

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features which further define the present invention over the references of record. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103(a).


Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present paper is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipate or render obvious Applicants' invention. In addition, the applied references of record have been discussed and distinguished, while significant features of the present invention have been pointed out. Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to be appropriate.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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